

REMARKS**Status of the Claims**

Claims 34 and 37-38 are amended and claim 40 is cancelled without prejudice or disclaimer. No new matter has been added. Upon entry of this Amendment, claims 1-39 are pending, and elected claims 1-6, 8, and 10-39 should be examined. Species claims 7 and 9 should be rejoined as a matter of right when the base generic claim 1, from which claims 7 and 9 depend is allowable.

Claim Objections

Claim 38 has been objected to on the grounds that a period is missing at the end of the claim. Applicants appreciate the Examiner's observation and believe the present version of the claim avoids this issue.

Rejections- 35 U.S.C. § 112, first paragraph (Enablement)

Claims 34-37 are rejected under 35 U.S.C. § 112, first paragraph, for alleged lack of enablement. Specifically, the PTO asserts that the specification does not provide guidance for a method of "preventing" angiotension II-mediated diseases. See Office Action, pages 3-4. The present version of claims 34-37 avoids this issue, and therefore, the rejection should be withdrawn.

Rejections- 35 U.S.C. § 112, second paragraph (Indefiniteness)

Claims 38-40 are rejected under 35 U.S.C. § 112, second paragraph, for alleged indefiniteness. Specifically, the PTO asserts that claims 38 is indefinite because "[i]t is unclear how absorption occurs by just adding a compound to a support and base." Office Action, page 4, item 6. Similarly, claim 39 is alleged indefinite on the grounds that "it is unclear how the method of regulating percutaneous absorption occurs by simply adding other ingredients to the preparation." Office Action, page 4, item 6. Applicants respectfully traverse this rejection, as claims do not have to recite mechanisms of operation, nor is Applicant required to state such mechanisms. MPEP § 2173.

A claim is sufficiently definite to satisfy the statutory requirement of 35 U.S.C. § 112, second paragraph, if one of ordinary skill in the art would understand the bounds of the claim when read in light of the specification. Miles Labs., Inc. v. Shandon, Inc., 997 F.2d 870, 875, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993). Most importantly here, a claim is definite if it is amenable to construction, however confusing that task may be. Exxon, 265 F.3d at 1375, 60 USPQ2d at 1276. In other words, if the meaning of the claim is discernible, the claim avoids a rejection on indefiniteness grounds. Id.

In this rejection, claims 38-39 are amenable to claim construction, since the meaning of “absorption” is available from dictionaries. Since the meaning of claims 38-39 is discernible, claims 38-39 avoid rejection on indefiniteness grounds. Thus, the rejection should be withdrawn.

Claim 40 has been rejected on the grounds that “since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass.” See Office Action, page 4, item 7. As claim 40 has been cancelled, the rejection is obviated. Therefore, Applicants respectfully request withdrawal of the rejection.

Rejections- 35 U.S.C. § 101

Claim 40 has been rejected under 35 U.S.C. §101 on the grounds that the claim allegedly recites an improper definition of a process. See Office Action, page 5. Claim 40 has been cancelled, and thus the rejection is made moot.

Rejections- 35 U.S.C. § 102(b)

Claims 1, 6, 8, 22, 29-30, and 32-34 are rejected under 35 U.S.C. § 102(b) as allegedly anticipated by SmithKline Beecham Co. (WO 95/06410). Applicants respectfully traverse this rejection.

A reference anticipates a claim only if that reference describes each and every element of the claim. MPEP § 2131. If even just one element is absent from the reference’s particular disclosure, that disclosure neither describes nor anticipates the claim. Id. Such is the case in this rejection.

According to the PTO, SmithKline Beecham Co. “does not disclose the skin-contacting base (i.e. adhesive layer) containing the compound and a support (i.e. backing layer). Office Action, page 7. Therefore, according to the evidence and explanation of record, SmithKline Beecham and Co. would not describe the claimed invention. Accordingly, SmithKline Beecham does not anticipate claims 1, 6, 8, 22, 29-30, and 32-34. Applicants respectfully request reconsideration and withdrawal of the rejections.

Rejections- 35 U.S.C. § 103

Claims 1-6, 8, and 10-40 are rejected under 35 U.S.C. 103(a) as allegedly unpatentable over SmithKline Beecham Co. (WO 95/06410) in view of Katz et al. (U.S. Patent No. 5,028,435). Applicants respectfully traverse this rejection.

The PTO admits that SmithKline Beecham is deficient. This deficiency, according to the PTO, is remedied by combining SmithKline Beecham’s teachings with those of Katz. According to the PTO, the use of the angiotension II receptor antagonist in the invention of Katz is possible because Katz in column 5, lines 47-48 teaches that cardioactive drugs may be employed by the system.

Yet even if Katz were to make the technology possible, a combination is not made proper merely because the teachings may be combined. MPEP § 2143.01. Absent from the evidence and explanation is any desirable reason to choose these elements for combination for any reason. The required motivation cannot be established by discussing how references might be combined.

And even if Katz were to teach “cardioactive drugs, anti-virals, analgesics, etc.,” as urged by the PTO, that would not be a reason to zero in on SmithKline Beecham’s compounds. There are so many “cardioactive drugs, anti-virals, analgesics” that the references must suggest the desirability of SmithKline Beecham’s compounds not as members of a class but as particular species. MPEP § 2144.08. Yet absent from the record is a desirable reason to choose SmithKline Beecham’s compounds as a species. Thus, the rejection is improper and should be withdrawn.

CONCLUSION

As the above-presented amendments and remarks address and avoids all of the rejections presented by the Examiner, withdrawal of the rejections and allowance of the claims are respectfully requested. No new matter has been added.


If there are any questions concerning this application, the Examiner is courteously invited to contact the undersigned counsel.

Respectfully submitted,

Date

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